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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,888	07/15/2003	Paul J. Thompson	23,369-153	7451

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PATENT DEPARTMENT  
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EXAMINER

PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/619,888

Applicant(s)

THOMPSON, PAUL J.

Examiner

Paul B. Prebilic

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 54-94 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 54-56 and 58-94 is/are rejected.
- 7) ☒ Claim(s) 57 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/18/03 + 1/5/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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### ***Claim Objections***

Claim 54 is objected to because of the following informalities: On line 10 of claim 54, the term "access" is not understood in the context of the present invention as disclosed. The Examiner believes that the term "axis" was intended here based upon the language of the other independent claim; see claim 83, line 13. Therefore, the Examiner will interpret claim 54 as if the term "axis" was present where "access" is now used. Appropriate correction or clarification is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 54 and 68-94 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10, 14, and 23-37 of U.S. Patent No. 6,592,617. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are broader in scope than the patented claims but are drawn to the same embodiment, and only the existence of product-by-process limitations of the patented claims make the language

different from that of the present claims. Since the present claims are read on by the patented claims, they are considered to be obvious in view thereof.

Claims 58 and 59 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,689,162. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are broader in scope than the patented claims but are drawn to the same embodiment. Since the present claims are read on by the patented claims, they are considered to be obvious in view thereof.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 54-56, 60-69, 73-77, 80, and 82-94 are rejected under 35 U.S.C. 102(e) as anticipated by Schmitt et al (US 5,697,969). Schmitt et al anticipates the claim language wherein the structural strands are the non-absorbable strands (e.g. polyester monofilaments (32) or (42)), which are heat-set within the braid to retain their shape within the braid, and thus, they have a helical shape and tubular profile; see Figures 3 to 10, Examples 2 to 6 and column 2, lines 8-22.

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Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schmitt et al (US 5,697,969) in view of Pinchuk (US 5,092,877). Schmitt et al fails to teach the use of drug eluting fibers therewith. Pinchuk, however, teaches that it has been known to use drug-eluting fibers in similar devices; see column 7, lines 9-34. Hence, it is the Examiner's position that it would have been obvious to use drug-eluting fibers in the Schmitt et al invention so that, for example, the restenosis of the blood vessel in the vicinity of the implant could be further prevented by the drug being released.

Claims 70-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmitt et al (US 5,697,969) alone.

With regard to claims 70-72, Schmitt et al fails to set forth the particular filament size range as claimed. However, the Examiner posits that the claimed filament size range would have been obvious in view of Schmitt et al, which uses multi-filament yarns of the same denier in the same environment of use as the Applicant. Therefore, since no criticality of unexpected result has been shown for the particular filament size range claimed, the Examiner posits that it would have been obvious and a matter of design choice to select one.

Claims 78-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmitt et al (US 5,697,969) in view of Engelson et al (US 5,423,849). Schmitt fails to disclose the use of a radiopaque fiber therewith. Engelson et al, however, teaches that it has been known to use radiopaque fibers in similar braided implants. Hence, it is the Examiner's position that it would have been obvious to interbraid a radiopaque fiber into the braid of Schmitt et al for the same reasons that Engelson et al does the same and

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so that the Schmitt et al device would be readily viewable during implantation and after by an X-ray apparatus.

Claims 58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmitt et al (US 5,697,969) in view of Wallsten (US 5,061,275). Schmitt fails to disclose the use of a catheter to insert the graft thereof into the body. Wallsten, however, teaches that it has been known to do such; see Col. 15, line 17-35. Hence, it is the Examiner's position that it would have been obvious to use a catheter to insert the graft of Schmitt et al into the blood vessel site to be treated so that the graft is protected from picking up debris prior to insertion at the site of interest.

#### ***Allowable Subject Matter***

Claim 57 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul B. Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on (703) 308-2111. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilic  
Primary Examiner  
Art Unit 3738